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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,120	10/03/2003	Charles Lee Edwards	TH1647 04 (US)	4639

7590

04/27/2004

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EXAMINER

VOLLANO, JEAN F

ART UNIT

PAPER NUMBER

1621

DATE MAILED: 04/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/679,120	<b>Applicant(s)</b> EDWARDS ET AL.	
	<b>Examiner</b> Jean F. Vollano	<b>Art Unit</b> 1621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 30-38 and 49-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30-38 and 49-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/3/2003</u> | 6) <input type="checkbox"/> Other: ____  |

**DETAILED ACTION**

1. The election filed 4/5/2004 has been entered. Applicant notes that there was a submission on the transmittal form to cancel claims 1-29, 39-46 and 50-54 were canceled and only 30-38 and 47-49 remain ( as originally numbered). The examiner stated that the claims had been renumbered under Rule 126 to claims 1-56 due to the duplicate of claims 40-41. Applicant also states that "However, the Applicants wish to point out that only claims 30-38 and 40-49, which form Group IV from the original restriction requirement in the parent case, are present in this application. The Examiner's attention is directed to the utility patent application transmittal Section 4.c. The Applicants assert that these claims are all correctly linked together as described in the original restriction requirement in the parent case, Group IV. The Applicants assert that this argument overcomes the restriction requirement." The examiner notes that as rewritten the claims canceled are 1-29, 39-48 and 52-56 (both claims 40-41 are apparently canceled). The remaining claims left under the new numbering system are claims 30-38, and 49-51 (which are in Group IV as specified by this examiner in the restriction of 3/18/2004) according to the new numbering system under Rule 126 and according to the restriction by the present examiner. The examiner is confused as to why applicant thinks claims 40-49 are present when 36-46 ( which are now 36-48) were canceled. . Please remember to list your elected claims as 30-38 and 49-51 which is in accordance to the number changes of Rule 126 . These are the only claims present and the restriction is withdrawn. Claims 30-38 and 49-51 do form one group.

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***Priority***

2. The priority data has been placed in the specification in the first sentence as follows: “

This is a division of Application Serial No. 10/025,080 filed December 19, 2001, the entire disclosure of which is hereby incorporated by reference, which claims the benefit of U.S.

Provisional Application No. 60/257,670 filed December 21, 2000, the entire disclosure of which is hereby incorporated by reference. The divisional has matured into a patent and therefore according to the MPEP : “The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression “now Patent No. \_\_\_\_\_” should follow the filing date of the parent application. Please make the appropriate correction.

***Claim Rejections - 35 USC § 112***

Claims 30-38 and 49-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation of “a hydrocarbyl radical... an alkylene radical. A radical is an ion such as a cation or anion or the term can be used to describe a free radical which has a one unpaired electron. It is unclear what is being stated by the term radical. There is a similar problem in claims 31, 31, 33.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 30-31, 33-34, 49 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Chem abs 816 (CA:96:34816).

When Chem abs 816 exemplifies a compound of the formula in claim 30 which has x as 0, R2 as methyl A as propyl and y as 1 then the claims are fully anticipated

The examiner notes that since x is 0 R1 can be hydrogen or anything listed since it is deleted by x being 0.

4. Claims 30-31, 33, 34, 49 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Chem abs 141 (CA:131:89141).

When Chem abs 141 exemplifies a compound of the formula in claim 30 which has x as 0, R2 as methyl A as propyl and y as 2 then the claims are fully anticipated


5. Claims 32 and 35-38 are not anticipated or suggested in the prior art. It is noted that on the PTO 1449 that in WO 94/05761 the first compound structure on page 8 is very similar to the compounds being claimed except that there is no branching on the n-C<sub>4</sub>H<sub>9</sub> portion of the molecule and no suggestion of a branched form of C<sub>4</sub>H<sub>9</sub>.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean F. Vollano whose telephone number is 571-2720648. The examiner can normally be reached on Monday-Thursday 6:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272- 0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jean F. Vollano  
Primary Examiner  
Art Unit 1621

April 25, 2004